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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,489

03/01/2004

Serge Carillo

ST94037B

9027

29693

7590

11/26/2008

WILEY REIN LLP
1776 K. STREET N.W.
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EXAMINER

LONG, SCOTT

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/788,489</p>	<p>Applicant(s) CARILLO ET AL.</p>	
	<p>Examiner SCOTT LONG</p>	<p>Art Unit 1633</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 30 October 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-8.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Janet L. Epps-Ford/
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: The applicant has argued (Remarks, page 5 bridging page 6, filed 10/30/2008) that the examiner's claim interpretation is "nonsensical." The applicant further states, "applicant's have amended claim 1 to fully clarify that the peptide or protein inhibitor of calpain protease activity is administered to the cell extract." (Remarks, page 6, lines 19-21). Since the disputed claim interpretation has been amended to further limit the claims, the examiner believes this would require further search and consideration. Accordingly, the proposed amendments will not be entered.

Continuation of 11. does NOT place the application in condition for allowance because:

The applicant contends that the last Action (filed 4/30/2008) was improperly made final, because the new grounds of rejection was not necessitated by applicant's claim amendment. The finds the applicant's argument unpersuasive because the nature of the claim language (which also necessitated a 112-2nd rejection, regarding "an inhibitor") was sufficiently broad to allow the examiner to apply art rejections which read on the originally filed claims, whereas the amended claims (filed 2/19/2008) could no longer be viewed as anticipatory or obvious over the cited art. Therefore, a new grounds of rejection was required. The examiner considered this rejection necessitated by amendment.

The applicant has argued (Remarks, page 5 bridging page 6, filed 10/30/2008) that the examiner's claim interpretation is "nonsensical." The applicant further states, "applicants have amended claim 1 to fully clarify that the peptide or protein inhibitor of calpain protease activity is administered to the cell extract." (Remarks, page 6, lines 19-21). Since the disputed claim interpretation has been amended to further limit the claims, the examiner believes this would require further search and consideration. Accordingly, the proposed amendments will not be entered.

The applicant requests reconsideration of the 35 USC 103 rejection. In particular, the applicant argues that the cited art fails to teach "step 2 of claim 1, i.e., 'administering a peptide or protein inhibitor of calpain'" (Remarks, page 5, lines 10-12). Contrary to the applicant's assertion, the examiner indicated (Action, page 7, filed 4/30/2008) "Henkart et al. teach 'a particularly useful calpain inhibitor is...synthetic oligopeptides.'" Squier et al. also teach administration of a peptide, Calpain inhibitor 1 (Action, page 8, lines 9-10, filed 4/30/2008). Accordingly, the examiner finds the applicant's argument unpersuasive.

Accordingly, the claims remain rejected for the reasons of record.

/SDL/ Scott Long
Patent Examiner, Art Unit 1633